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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/009,083  | 03/20/2002  | George Endel Deckner | AA399XM             | 5574             |
| 27752   | 7590        | 09/09/2004           | EXAMINER            |                  |
| THE PROCTER & GAMBLE COMPANY<br>INTELLECTUAL PROPERTY DIVISION<br>WINTON HILL TECHNICAL CENTER - BOX 161<br>6110 CENTER HILL AVENUE<br>CINCINNATI, OH 45224 |             |                      | QAZI, SABIHA NAIM   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1616                |                  |

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



**Non-Final Office Action on Merits**

Claims 1-37 are pending. No claim is allowed.

This application is a 371 national stage entry of PCT/US00/13842, filed on May 19, 2000; this applications claims priority from PCT/US00/13842.

The previous rejection is withdrawn, as was requested.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: Claim 1 is drawn to an absorbent article comprising a body contacting surface and an absorbing core, wherein (1) at least a portion of the body contacting surface and (2) the skin care composition having specific viscosity.

Claim 30 additionally contains skin care composition comprising a skin care active agent.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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The claims are deemed to correspond to the species listed above in the following manner:

Claims 1 and 30 are generic.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

**Response to Election of Species Remarks**

There were two points made in the response filed on July 2, 2004.

The first point was that the Office Action cited an MPEP section that did not exist. Examiner would like to apologize for a typing error. The first Office Action (mailed on December 3, 2003) had the correct MPEP citation: "MPEP § 809.02(a)" (page 1).

The second point the Applicants made was that the election of species was inappropriate. Examiner respectfully disagrees. Examiner directs the Applicants' attention to MPEP § 809.02(a), which states:

**"National Stage Election of Species in 35 U.S.C. 371 Applications**

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. The species are as follows:

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[ 1 ] Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a)”

Examiner disagrees that it is not a burden on the Examiner to search the art. It is a common practice to elect a species, as cited above.

In the response filed on January 15, 2004, the Applicants elect species of Claim 1, which is incorrect. Claim 1 cannot be an elected species. The elected species should contain each ingredient necessary for the claimed composition. It may be any exemplified composition disclosed in the Specification. Elected species is not a broad claim, as was elected by the Applicants.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over OSBORN et al (WO 98/55158), VAN RIJSWIJCK et al (WO 99/12530), and ROE et al (WO 99/22684). The presently claimed invention is generically taught by the prior art.

OSBORN et al teaches an absorbent device that is pretreated with an emollient composition. See the entire document, especially the abstract, examples, claims, the third paragraph on page 21, the last paragraph on page 22, and all of page 23.

VAN RIJSWIJCK et al teaches a skin care composition that provides a therapeutic and/or protective skin benefit upon transfer to the skin by a device. See the entire document, especially the abstract, claims, examples, the first paragraph on page 13, all of page 14, and the first & second paragraphs on page 19.

ROE et al teaches a skin care composition to maintain and/or improve skin health of the wearer upon transfer during use. It also teaches semisolid compositions. See the entire document, especially the abstract, examples, claims, and the first paragraph of page 41.

Instant claims differ from the prior art in claiming a broader scope.

It would have been obvious to one skilled in the art at the time of invention to prepare an absorbent article comprising a body contacting surface and an absorbent core by containing a skin care composition because the prior art teaches it. There is motivation to prepare the

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presently claimed invention by selecting the ingredients taught by the prior art *supra* for the same use.

In absence of any criticality and/or unexpected results, presently claimed invention is considered *prima facie* obvious over the prior art of record.

The Examiner notes the proportions, ranges, ratios, concentrations, and temperatures are claimed in various independent claims. It has been established that normally, change in temperature, concentration, or both, is not a patentable modification; however, such changes may impart patentability to a process if the ranges claimed produce a new and unexpected result which is different in kind and not merely in degree from results of prior art; such ranges are termed "critical" ranges, and applicant has burden of proving such criticality; even though applicant's modification results in great improvement and utility over prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art; more particularly, where the general conditions of the claim are disclosed in the prior art, it is not inventive to discover optimum or workable ranges by routine experimentation. *In re Aller et al.* 105 USPQ 233.

It is well established that merely selecting proportions and ranges is not patentable absent a showing of criticality. *In re Becket*, 33 U.S.P.Q. 33 (C.C.P.A. 1937). *In re Russell*, 439 F.2d 1228, 169 U.S.P.Q. 426 (C.C.P.A. 1971).

It is a general rule that merely discovering and claiming a new benefit of an *old* process cannot render the process again patentable. Nor can patentability be found in differences in ranges recited in the claims. When the difference between the claimed invention and the prior art is some range or other variable within the claims, the applicant must show that the particular

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range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range. *In re Woodruff*, 16 USPQ2d 1934.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.



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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by GATTO et al (US 6570054 B1). GATTO et al teaches an absorbent article having a stable skin care composition disposed on its skin-contacting surface. See the entire document, especially the abstract and claims.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

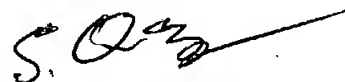
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Saturday, September 4, 2004

  
SABIHA QAZI, PH.D  
PRIMARY EXAMINER